

REMARKS

A. Status of the Claims

Claims 3 and 4 were pending at the issuance of the instant Office Action mailed on January 5, 2009. Claims 3 and 4 are rejected in the instant Office Action. Claim 3 is amended and Claim 4 is canceled herein. The rejections of the Office Action are traversed for the reasons set forth below.

B. Disclosure of Office Action in Application No. 10/531,754

Applicants wish to make the Examiner aware of Application No. 10/531,754, which shares a common specification with the present application. Application No. 10/531,754 is no longer pending, but had an Office Action on the merits mailed May 13, 2008. Applicants believe the Examiner has access to the Office Action, but will provide a copy if requested.

C. Rejections under 35 USC §112

Claims 3 and 4 are rejected under 35 USC §112, first paragraph, as allegedly failing to comply with the written description requirement for reciting the phrase “an ocular neovascular or edematous disease or disorder.” Solely to expedite prosecution, Claim 3 has been amended to recite the particular diseases and disorders previously set forth in Claim 4, which has been canceled. Applicants submit that Claim 3 satisfies the written description requirement, and respectfully request that the rejection be withdrawn.

D. Rejections under 35 USC §103

Claims 3 and 4 are rejected under 35 USC §103 as being unpatentable over Bressi *et al.* In particular, the Action asserts that one of skill in the art would have been motivated to use the compound of the instant claims to treat macular degeneration and diabetic retinopathy based on the teachings in Bressi *et al.* The Action also asserts that “the prior art is also very clear in using the compounds with HDAC inhibitory activity for the treatment of ocular

neovascular disorders,” and that “it would have been obvious to a person skilled in the art to substitute any compound having HDAC inhibitory activity for another and use it for the treatment of neovascular disorders given that such compounds share the same function, which is HDAC inhibition” (Office Action, page 6). Applicants respectfully traverse.

As discussed in Applicants’ response to the previous Office Action mailed March 27, 2008, “the rationale to support a conclusion that the claim would have been obvious is that the substitution of one known element for another yields predictable results to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art” (see MPEP 2143(B)). Further, as stated in MPEP 2143.02(II), “obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness” (citing *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976)).

Applicants submit that there is no evidence that it would have been obvious to substitute *any* HDAC inhibitor for one of the Bressi compounds. In Applicants’ previous response, it was pointed out that Bressi *et al.* teach a multitude of HDAC inhibitors, all of which are related by the general formula shown in the Abstract of US Patent No. 7,154,002 (“the ‘002 patent”), and as discussed in Col. 53, Example 3, of the ‘002 patent, Bressi *et al.* demonstrated that the compounds had varying activities against the HDAC8 isoform, where only some had better than 5 μ M activity (see Figures 5A and 5B). The Bressi compounds were not tested for activity against other HDACs. Even though Bressi *et al.* mention that the compounds may be used as inhibitors of Class I HDACs (Col. 11, lines 52-54), there is absolutely no evidence that such compounds can inhibit any of the isoforms in Class I other than HDAC8 (*i.e.* HDAC1, 2, 3, or 11). Further, Bressi *et al.* mention (but do not claim) several examples of HDAC inhibitors, such as SAHA; however, only the claimed compounds are taught to be useful for treating the various diseases listed in the Bressi patent. Thus, Bressi *et al.* teach that a *specific* genus of HDAC inhibitors that are active against HDAC8 are useful for treating macular degeneration and diabetic retinopathy, but do not teach that *all* HDAC inhibitors are useful for such a purpose. Therefore, one of skill in the art could not have known whether it was activity against HDAC8 specifically or against any HDAC

isoform (or any combination of HDAC isoforms) that would be useful for treating the many diseases listed in the Bressi patent.

The Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Here, the Action does not provide an articulated reasoning with a rational underpinning that explains why one of skill in the art would consider **any** HDAC inhibitor to be useful for treating the diseases and disorders recited in the instant claims, where the cited art relates to a specific genus of HDAC inhibitors. Bressi does not teach that inhibiting **any** HDAC isoform would have the same effect as inhibiting HDAC8.

The Federal Circuit in *Pharmastem Therapeutics, Inc. v. Viacell, Inc.* citing *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988), indicated that an invention would not be invalid for obviousness if the inventor would have been motivated “to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007). Since there are numerous human HDACs and a vast number of inhibitors to the various HDACs, and since Bressi relates to HDAC8 inhibitors, Applicants respectfully submit that the Action should point out how Bressi indicates or directs one of skill in the art to the specific HDAC inhibitors of the instant claims. Instead, the Action merely makes a generalized, conclusory statement that one of skill in the art would simply recognize that **any** HDAC inhibitor would be useful to treat neovascular disorders based on HDAC inhibition activity. In contrast, as pointed out above, the teachings of Bressi focus on HDAC8 inhibitors, not HDAC inhibitor activity generally.

Therefore, Applicants submit that the claims are not obvious over Bressi *et al.*, and respectfully request that this ground of rejection be withdrawn.

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E. Obviousness-type Double Patenting

Claims 3 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being upatentable over claims 1, 3, and 4 of copending Application No. 11/836,309; claims 1 and 3 of copending Application No. 10/531,747; and claims 1 and 3-5 of copending Application No. 10/694,309. A terminal disclaimer is submitted herewith, thereby obviating the double patenting rejection with respect to Application No. 10/694,309, Application No. 10/531,747, and Application No. 11/836,309.

F. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 615-5330 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

/Jason J. Derry, #50,692/

Jason J. Derry, Ph.D.
Reg. No. 50,692
Attorney for Applicants

ALCON RESEARCH, LTD.
6201 S. Freeway, TB4-8
Fort Worth, TX 76134-2099
(817) 615-5330

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